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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,137	07/23/2003	Murat O. Arcasoy	5405-275	8278

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EXAMINER

XIE, XIAOZHEN

ART UNIT PAPER NUMBER

1646

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,137

Applicant(s)

ARCASOY ET AL.

Examiner

Xiaozhen Xie

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 and 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20031218.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application, Amendments, And/Or Claims***

The Information Disclosure Statement (IDS) filed 18 December 2003 has been entered in full. Applicant's amendment of the claims filed 29 August 2005 has been entered.

### ***Election/Restriction***

Applicant's election with traverse of Group I and SPECIES A (SEQ ID NO: 4) in the reply filed on 29 August 2005 is acknowledged. The traversal is on the ground(s) that Group V and VI relate to Group I as methods of using a compound, and therefore should be examined together with Group I. MPEP 806.05(h) states, "a product and a process of using the product can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product; or (2) the product as claimed can be used in a materially different process". As described in the Office Action of 28 July 2005, the nucleic acid of Group I can be used in a materially different process from the method of Group V, and the nucleic acid of Group I is not used or otherwise involved in the method of Group VI, see MPEP 806.04 and MPEP 808.01.

The requirement is still deemed proper and is therefore made FINAL. Claims 3-6, 10-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1-2 and 7-9 are under examination.

### ***Specification***

The disclosure is objected to because of the following informalities:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Novelty is a legal concept and does not describe the invention claimed. Novelty is required of all claimed inventions before they are issued as patents. To use the term in the title would imply merit in this regard without actual examination. A suggestion for the title is to remove the word "novel".

The abstract of the disclosure is objected to because it includes legal phraseology ("herein"). Correction is required. See MPEP 608.01(b).

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

- a) it recites non-elected inventions;
- b) it is missing the word "and" before "a nucleic acid that encodes the opposite strand of a nucleic acid as set forth above". Without the "and", it is improper Markush language.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated host cell in culture comprising a polynucleotide with the sequence as set forth in SEQ ID NO: 4, does not reasonably provide enablement for host cells in the context of transgenic animals or gene therapy as recited in claim 9.

The claim recites that the nucleic acid of the current invention can be expressed in a wide variety of host cell types, including cells within a host animal. However, there are no actual or prophetic examples that disclose how to make or use host cells that comprise a DNA sequence as set forth in SEQ ID NO: 4 in an animal. Eck & Wilson (page 81, column 2, second paragraph to page 82, column 1, second paragraph) report that numerous factors that complicate *in vivo* gene expression, have not been shown to be overcome by routine experimentation. These include, the fate of the DNA vector itself (volume distribution, rate of clearance into the tissues, etc.), the *in vivo* consequences of altered gene expression and protein function, the fraction of vector taken up by the target cell population, the trafficking of the genetic material within cellular organelles, the rate of degradation of the DNA, the level of mRNA produced, the stability of the mRNA produced, the amount and stability of the protein produced, and the protein's compartmentalization within the cell, or its secretion fate, once produced. Since the instant disclosure does not address any of the methods necessary to make a host cell in an animal which comprises the polynucleotide of interest, the claims as

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written are not enabled. This issue could be overcome by addition of the limitation to claim 9 wherein the host cells are isolated.

***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a nucleic acid that encodes the opposite strand of a nucleic acid as set forth above". Nucleic acids do not "encode" opposite strands of nucleic acids, and they encode proteins. Suggest "the full length complement of SEQ ID NO: 4" instead.

Claims 2 and 7-9 are rejected for being dependant claims of claim 1.

**Conclusion**

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiaozhen Xie, Ph.D whose telephone number is 571-272-5569. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D can be reached on 571-272-0829. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ELIZABETH KEMMERER  
PRIMARY EXAMINER

Xiaozhen Xie, Ph.D  
October 25, 2005